

IN THE UNITED STATES PATENT & TRADEMARK OFFICERECEIVED
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DEC 22 2003

Applicants: Robertson *et al.*

Docket No: F-7561

Serial No: 10/074,736

Examiner: Z. T. Pittman

Filed: 29 October 2001

Art Unit: 1725

Title: Method of Joining Material

Date: 18 September 2003

OFFICIAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY UNDER 37 CFR § 1.121

The Office Action dated 18 June 2003 ("Office Action") rejected claims 1-6 and 8-23 as being unpatentable. Applicants traverse the rejection, and make no amendments to the application.

Claim Rejection - 35 U.S.C. § 103(a)

The Office Action rejected claims 1-6 and 8-23 as being unpatentable over United States Patent Number 5,205,465 to Bogard *et al.* ("Bogard") in view of 5,272,809 to Robertson *et al.* ("Robertson"). Applicants assert that the Examiner failed to establish a *prima facie* case of obviousness.

A *prima facie* case of obviousness must meet three criteria. M.P.E.P. § 2143. First, a motivation must exist to combine the references. *Id.* Second, the combination must have a reasonable expectation of success. *Id.* Finally, the references must teach or suggest all the claim limitations. *Id.* Applicants believe the Office Action failed to establish at least two of these criteria.

First, the Office Action failed to establish a valid motivation to combine the references. The motivation alleged in the Office Action to combine Bogard and Robertson was "to minimize distortion,

optimize properties and stress relieve the bonded assembly." However, the Office Action failed to indicate where the Examiner discovered such motivation. Applicants remind the Examiner that "[t]he teaching or suggestion to make the claimed combination ... must ... found in the prior art, not in applicant's disclosure." *Id.* Since the Examiner failed to indicate where such motivation exists in the prior art, the rejection was improper and must be withdrawn for at least this reason.

Second, the Office Action also failed to establish a reasonable expectation of success in combining Bogard and Robertson. Applicants remind the Examiner that "the reasonable expectation of success must ... be found in the prior art, not in applicant's disclosure." Since the Examiner failed to indicate where such reasonable expectation of success exists in the prior art, the rejection was improper and must be withdrawn for at least this reason.

Conclusion

In light of the foregoing, Applicants submit that the Application is in condition for allowance. Applicants request that the Examiner reconsider and withdraw the rejection. Applicants solicit the allowance of claims 1-6 and 8-23 at an early date.

Respectfully submitted,



Brian J. Hamilla
Registration Number 38,482
Attorney for Applicants